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Teruo Masaki

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EXAMINER

LUDWIG, PETER L

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

05/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/033,206

Applicant(s)

MASAKI ET AL.

Examiner

Peter L. Ludwig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This Office Action is given Paper No. 20070425 for reference purposes only.
2. This Office Action is in response to Applicants amendment filed on 01/26/2007.
3. Claims 1, 5, 6, 12, 13, and 17 have been amended and claims 1-17 are currently pending.

Response to Arguments

4. Applicants arguments received on 1/26/2007 have been fully considered but they are not persuasive in regard to the new grounds of rejection. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility and brought in the Erickson reference to complete the new grounds of rejection of the claims.

5. The Applicant has argued that Stefik does not teach the arranging step and the detecting step of claim 1. More specifically, such arranging and detecting steps of claim 1 utilizing a gateway. The Examiner has asserted that Stefik does not teach the use of such gateway and has brought in the Erickson reference to fulfill the gateway usage as described by Applicant.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 5, 6, 12, 13, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1, 5, 6, 12, 13, and 17 recite the limitation "the determined result" in the last limitation of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (U.S. Patent No. 5,629,980) in view of Erickson (U.S. Patent No. 5,765,152) in further view of Applicant's own admission's.

10. As per claims 1-17, Stefik discloses the prevention of the unauthorized distribution of copyrighted digital works, thereby disclosing the limitations of claims 1-17. See at least the abstract; column 1, lines 10-13; column 1, lines 44-46; column 2, lines 1-22; Figure 1 and associated text, as well as other relevant text throughout the reference. Stefik also discloses a deletion function, but does not specifically disclose destroying communication data. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Stefik's deletion technique to include deleting any files and/or associated with an unauthorized transfer of digital material because this would likely inhibit or prevent a fraudulent digital file transaction from occurring.

In addition, although Stefik does disclose deletion of data, Stefik does not disclose *"program data for causing the copyrighted work data to be prohibited from being transmitted is transmitted to the client"*, as claimed in, for example, claim 4. However, the Applicant in the background of the specification does. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Stefik with Applicant's admissions because

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preventing fraudulent use of digital copyrighted data entails deletion of digital data, as disclosed by both Stefik and Applicant.

11. With regard to the amended limitation of *“arranging a gateway between the first communication network and the second communication network such that data transmitted between the first communication network and the second communication network is supplied to the gateway”*, Applicant argues Stefik does not disclose this amended limitation. However, Erickson which discloses a means of transferring copyrighted licensed material from one communication network to a server coupled to a second communication network, wherein the transacted data must pass via a gateway in order to be transacted (see at least the abstract and Fig. 1) does teach this. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Erickson with Stefik for the useful purpose of allowing the authorization server or “gateway” to protect the licensing of such copyrighted material, as taught by Erickson. There are many useful purposes of having a gateway to ensure the licenses have been distributed correctly and to protect against the illegal usage of such data.

12. With regard to the amended limitation of *“detecting at the gateway whether copyrighted work data in communication data uploaded from a client which is desired to be supplied to the server”*, Applicant argues that Stefik et al. fails to teach or suggest sending copyrighted data from a client machine to a server. Stefik discloses sending copyrighted material from a server to a client. Applicant, in the background of the specification discloses uploading data from a client to a server. It would have been an obvious modification of Stefik to include transmitting protected data back to the server because, as disclosed by the Applicant on page 2 of the specification, “Using web pages, Internet addresses from... can be easily accessed.” In Figure 1

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of Stefik, a user is shown to create a digital work and upload it to a repository for controlled dissemination. Clearly, before a protected work can be downloaded from a server for rendering, it must first be uploaded. In addition, since Stefik clearly shows usage rights being attached to a user's uploaded digital work at item 102, the step of detecting whether a file is copyrighted work and being transmitted from the user's Pc to the repository is also disclosed. Inherently, if usage rights are attached to a file as a matter of course, the file transmitted as in figure 1 is copyrighted work.

Also, the limitation that all of this must happen "*at the gateway*" is clearly taught by Erickson (see at least the abstract and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Erickson with Stefik and/or Applicants own admission for the useful purpose of allowing the authorization server or "gateway" to protect the licensing of such copyrighted material, as taught by Erickson. There are many useful purposes of having a gateway to ensure the licenses have been distributed correctly and to protect against the illegal usage of such data.

Claim Interpretations

13. Although Applicant(s) use “means for” in the claim(s) (see *e.g.* claim 5), it is the Examiner’s position that the “means for” phrase(s) do not invoke 35 U.S.C. §112 6th paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of “means for” from the claim(s), or to explicitly state on the record why 35 U.S.C. §112 paragraph should not be invoked.

Alternatively, if Applicant(s) desire to invoke 35 U.S.C. §112 6th paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. §112 6th paragraph, the “means for” phrase(s) will be interpreted as set forth in the Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th and §2181.

Failure by Applicant(s) in their next response to also address the 35 U.S.C. §112 6th paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. §112 6th paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. §112 6th paragraph applies to all examined claims currently pending.

14. The USPTO interprets claim limitations that contain “*if, may, might, can, when and could*” statement(s), as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (In re Johnston, 77 USPQ2d 1788 (CA FC 2006)). Language that suggests or makes optional but does not require

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steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

15. To the extent that the Examiner's interpretations are in dispute with Applicants' interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.¹ Moreover, while the following list is provided in accordance with *In re Morris*, the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.² Finally, the following list is not intended to be exhaustive in any way:

16. **Server:** “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.³ **Client:** “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a server).” *Id.* **Computer:** “Any machine that

¹ While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

² See e.g. *Brookhill-Wilk I LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (abstract dictionary definitions are not alone determinative; “resort must always be made to the surrounding text of the claims in question”).

³ Based upon Applicants' disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled ‘New Terminology.’

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does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” Id.

17. **Gateway** “A gateway provides a link between disparate networks so they may communicate. The Internet has host nodes that are clients and servers. Systems that direct traffic in a network or at an ISP are gateway nodes. A server that is a gateway node in an enterprise may also be a proxy server and a firewall.” Dictionary of Multimedia and Internet Applications: A Guide for Developers and Users, John Wiley & Sons Ltd., 1999.

18. **Communication Network** “A netlike combination or pattern in which different elements are joined; specific uses include: *Computer Technology*: A loosely coupled group of functional units, such as computers. The computers, called nodes of the network, exchange messages over communication links.” Academic Press Dictionary of Science and Technology, Academic Press, 1992.

19. **Detect** “to notice or to discover.” Dictionary of Law, Peter Collin Publishing, 2000.

20. **Determining** “to decide or settle a discussion.” Dictionary of Library and Information Management, Peter Collin Publishing, 1997.

Examiner's Note

21. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

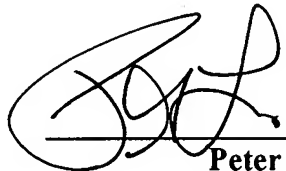
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Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

 4/26/2007
Peter L. Ludwig
Patent Examiner
Art Unit 3621

 4/3/07
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